

**REMARKS**

The above preliminary amendments and following remarks are submitted in accordance with a Request for Continued Examination filed on even date and in response to the Final Official Action of the Examiner mailed June 8, 2005. Having addressed all objections and grounds of rejection, claims 1-20, being all the pending claims, are now deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

The Examiner has rejected claims 1-14 and 16-20 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,754,772, issued to Leaf (hereinafter referred to as "Leaf"). This ground of rejection is respectfully traversed as to the amended claims for the reasons provided below.

In response to the Examiner's previous prior art rejections, Applicants have pointed to the limitation of conversion "without use of a view buffer" found limiting of all pending claims. In his response on page 1 of the pending official action, the Examiner states:

MPEP 2173.05(I) also discloses that "An negative limitation or exclusionary proviso must have basis in the original disclosure." (Examiner's emphasis added). In view of the specification, the Examiner is unable to find sufficient basis within the disclosure that teaches or suggests the claim limitation. The specification does not have a sufficient disclosure of a buffer and how the exclusion of such a buffer is advantageous. Furthermore, the response filed 24 January 2005 does not specifically

show the Examiner the support for the limitation within the disclosure. The Applicant must show where within the specification an adequate basis for such a limitation exists. Therefore, based on the recitations of the claim, the limitation is given little patentable weight.

This finding is both clearly erroneous as a matter of fact and non-compliant with controlling law.

It is clearly erroneous because the specification does discuss the matter of the use of a "view buffer" extensively. At page 1, lines 3-21, Applicants incorporate by reference a large number of references which utilize a "view buffer" and discuss the same at great length. The problem of using a "view buffer" is discussed in the Description of the Prior Art at page 6, line 17, through page 7, line 9. A summary of the solution is given at page 8, lines 2-6. The remainder of Applicants' disclosure explains in detail the method and apparatus for providing the desired interface both with and without the use of a "view buffer". As a result, the finding of the Examiner is clearly erroneous.

Even more significant is that the Examiner's finding does not comply with controlling law, including MPEP 2173.05(I) cited by the Examiner. For example, the Examiner's states:

The specification does not have a sufficient disclosure of a buffer and how the exclusion of such a buffer is advantageous.

Nowhere is this requirement supported in controlling law. As a practical matter, the Examiner attempts to add two new requirements for patentability. He would have Applicants provide

"a sufficient disclosure" of an element which is not part of the claimed invention. Secondly, he would require the specification to describe advantages for a particular combination of elements. Neither of these is required by MPEP 2173.05(I) or elsewhere in the law of patentability. The Examiner's position is contrary to law.

Furthermore, there is no provision in MPEP 2173.05(I) or elsewhere in controlling law for the Examiner to arbitrarily find, "based on the recitations of the claim, the limitation is given little patentable weight". It is respectfully requested that the Examiner comply with controlling law. If there is no basis in the original disclosure for a negative limitation, MPEP 2173.05(I) provides a different course of action for the Examiner.

Nevertheless, even though the pending rejections, in addition to being based upon clearly erroneous findings of fact, are contrary to controlling law, Applicants have herewith amended all pending claims to require the functions of "an adapter" as one technique for making the conversion without use of a "view buffer". Support for this amendment may be found in Fig. 3 and associated description in the specification at page 21. As a result, all pending claims are deemed allowable, even if the Examiner refuses to comply with MPEP 2173.05(I).

Claim 1, as amended, contains the "adapter" discussed above coupled between the claimed "user terminal" and the claimed "generic gateway". This limitation is not found in any of the

prior art of record. The rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and is further limited by "a second gateway.....wherein said second gateway converts....through the use of a view buffer". In other words, claim 2 requires a first gateway not using a view buffer and a second gateway which does use a view buffer. In making his rejection, the Examiner confusingly suggestions "instance of transaction gateway client". Whereas the Examiner is correct that Leaf teaches the use of more than one instance of the transaction gateway client, each instance performs conversion using a "view buffer". Thus, Leaf does not have a system which anticipates the invention of claim 2 in accordance with the requirements of MPEP 2131. The rejection of claim 2, and claims depending therefrom, is respectfully traversed.

Claim 3 depends from claim 2 and further limits the claimed network element. Because Leaf does not have all of the elements of claim 2, it cannot anticipate the unique combination claimed in claim 3. The rejection of claim 3 is respectfully traversed.

Claim 4 depends from claim 3 and further limits the claimed server and environment. Because Leaf does not have all of the elements of claim 3, it cannot anticipate the unique combination claimed in claim 4. The rejection of claim 4 is respectfully traversed.

Claim 5 depends from claim 4 and further limits the claimed user terminal element. Because Leaf does not have all of the elements of claim 4, it cannot anticipate the unique combination claimed in claim 5. The rejection of claim 5 is respectfully traversed.

In rejecting claim 6, the Examiner again clearly erroneously finds that Leaf, column 1, lines 25-27, and lines 57-67, teaches "a first gateway....which converts.....without the use of a view buffer". This finding is clearly erroneous and contrary to controlling law as explained above. Again, the Examiner clearly erroneous equates a "web browser" with the claimed user terminal and a "database engine" with the claimed enterprise server. Claim 6 as amended further requires an "adapter" not found in the prior art of record. The rejection of claim 6 is respectfully traversed for failure of the Examiner to meet the requirements of MPEP 2131. The rejection of claim 6, and all claims depending therefrom is respectfully traversed.

Claim 7 depends from claim 6 and is further limited by "a second gateway.....which converts ....with the use of a view buffer". As explained above, this means that claim 7 requires at least one gateway not using a view buffer and at least one gateway using a view buffer. Though Leaf teaches a plurality of instances, each instance requires the use of a view buffer. The rejection of claim 7 is respectfully traversed.

Claim 8 depends from claim 7 and further limits the claimed network element. Because Leaf does not have all of the elements of claim 7, it cannot anticipate the unique combination claimed in claim 8. The rejection of claim 8 is respectfully traversed.

Claim 9 depends from claim 8 and further limits the claimed server and environment. Because Leaf does not have all of the elements of claim 8, it cannot anticipate the unique combination claimed in claim 9. The rejection of claim 9 is respectfully traversed.

Claim 10 depends from claim 9 and further limits the claimed user terminal element. Because Leaf does not have all of the elements of claim 9, it cannot anticipate the unique combination claimed in claim 10. The rejection of claim 10 is respectfully traversed.

Claim 11 is an independent method claim having three basic steps. Leaf does teach either of the first two steps in accordance with the citation of the Examiner (i.e., column 1, lines 25-27, and lines 57-67), because there is no service request. Perhaps of more importance, Leaf does not expressly or inherently teach the "converting.....without the use of a view buffer" step in accordance with the requirements of MPEP 2131. In addition, claim 11, as amended, requires the "translating" step, which is not found

in the prior art of record. Therefore, the rejection of claim 11, and all claims depending therefrom, is respectfully traversed.

Claim 12 depends from claim 11 and is further limited by a transferring step. The citation of Leaf, column 1, lines 25-27, lines 57-67, and lines 63-65, do not teach this step, because they do not even mention the claimed "legacy data base management system". The rejection of claim 12, and claims depending therefrom, is respectfully traversed.

Claim 13 depends from claim 12 and further limits the claimed network element. Because Leaf does not have all of the elements of claim 12, it cannot anticipate the unique combination claimed in claim 13. The rejection of claim 13 is respectfully traversed.

Claim 14 depends from claim 13 and further limits the claimed first format. Because Leaf does not have all of the elements of claim 13, it cannot anticipate the unique combination claimed in claim 14. The rejection of claim 14 is respectfully traversed.

Claim 16 is an independent apparatus claim having "means-plus-function" limitations. Therefore, the claim is to be examined in accordance with the requirements of MPEP 2181, et seq. Again, the Examiner has made clearly erroneous findings with regard to Leaf, column 1, lines 25-27, and lines 57-67. Again, this citation of Leaf does not teach a "service request" and therefore cannot

meet any of the four structural elements of claim 16. And again, Leaf does not expressly or inherently teach "means....for converting....without using a view buffer". Again, amended claim 16 is limited by an "adapting means" not found in the prior art of record. The rejection of claim 16, and all claims depending therefrom, is respectfully traversed for failure of Leaf to meet the requirements of MPEP 2131.

Claim 17 depends from claim 16 and is further limited by "means....for transferring....via one of a plurality of connectors". Leaf has no such "plurality of connectors". The rejection of claim 17, and claims depending therefrom, is respectfully traversed for failure of Leaf to meet the requirements of MPEP 2131.

Claim 18 depends from claim 17 and further limits the claimed first format. Because Leaf does not have all of the elements of claim 17, it cannot anticipate the unique combination claimed in claim 18. The rejection of claim 18 is respectfully traversed.

Claim 19 depends from claim 18 and further limits the claimed network element. Because Leaf does not have all of the elements of claim 18, it cannot anticipate the unique combination claimed in claim 19. The rejection of claim 19 is respectfully traversed.

Claim 20 depends from claim 19 and further limits the claimed generating means element. Because Leaf does not have all of the elements of claim 19, it cannot anticipate the unique combination claimed in claim 20. The rejection of claim 20 is respectfully traversed.

Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Leaf in view of U.S. Patent No. 6,725,426, issued to Pavlov (hereinafter referred to as "Pavlov"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143.

To make a *prima facie* case of obviousness, the Examiner has the burden to present evidence and argument with regard to the following three factors: 1) motivation to make the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all elements of the claimed invention within the alleged combination. The Examiner has not made these three showings.

In attempting to show motivation for the combination of Pavlov with Leaf, the Examiner states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Leaf and Pavlov because one of ordinary skill would have recognized the advantages that XML has over HTML as taught within Pavlov and been motivated to combine the teachings of the

references in order to utilize the more advantageous XML format.

In other words, because XML format exists, it is obvious to combine Pavlov with Leaf for the purposes of finding claim 15 unpatentable. This is precisely the unsupported conclusion attacked by the Court of Appeals for the Federal Circuit stating in part:

Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence". *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999).

Therefore, the alleged combination of Pavlov with Leaf is not motivated as a matter of law.

The Examiner does not even mention his obligation to show "reasonable likelihood of success".

Finally, the alleged combination does not have the claimed elements even if it were motivated and likely to succeed. Claim 15 requires "Composing a service request in a XML". The cited portions of Leaf do not compose a service request at all, and Pavlov is dedicated to a "Mechanism for Translating between Word Processing Documents and XML Documents". Nowhere is there even a suggestion to compose a "service request" in XML. At most, Pavlov shows transfer of an XML document which is not the claimed service request.

The rejection of claim 15 is respectfully traversed for failure of the Examiner to make any of the three showings of a *prima facie* case of obviousness as required by MPEP 2143.

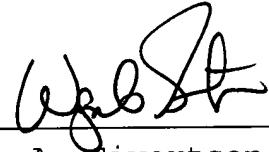
Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, as amended, being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

Daniel P. Starkovich et al.

By their attorney,



\_\_\_\_\_  
Wayne A. Sivertson

Reg. No. 25,645

Suite 401

Broadway Place East

3433 Broadway Street N.E.

Minneapolis, Minnesota

55413

(612) 331-1464

Date October 11, 2005